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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/018,336
Filing Date: October 30, 2001
Appellant(s): LETTMANN, BERNHARD

MAILED
AUG 23 2005
GROUP 1700

Mary E. Golota
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 23, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

This appeal involves claims 1-11, 14, 15, 17-28, 33 and 36. Claim 39 is not being appealed. (Claim 39 is depending on claim 34. Claim 34 stands as canceled).

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on May 23, 2005 has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grouping of Claims

The rejection of claims 1, 2 and 3 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7). The claims as listed by the appellant are not separately patentable.

(7) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

The rejection of claim 14 under 35 U.S.C. 112, 2nd paragraph for failing to precisely point out the scope of the claim is withdrawn in light of the Presently Amended claim 14 of May 23, 2005.

(8) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Evidence Relied Upon

| | | |
|--------------|------------------|---------------|
| 6,403,701 | Reusmann et al., | June 11, 2002 |
| EP 0 081 994 | Kawakami et al., | June 22, 1983 |

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11, 14, 15, 17-28, 33 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reusmann et al., U.S. Patent 6,403,701 in view of Kawakami et al., EP 0 081994.

Appellants admit that Claims 1, 2 and 3 are independent claims.

Independent claim 1 and dependent claims 4, 6, 7, 9-11, 14 and 15 discloses an aqueous coating material comprising a product formed by mixing of a base color (A1) comprising a binder, at least one pigment and at least one organic solvent with at least one aqueous color-imparting base color (A2) comprising a binder, at least one color pigment and water, and with a pigment-free aqueous varnish (B) comprising a binder and water; and optionally at least one rheology control additive (C).

Independent claim 2 and dependent claims 5, 8, 17, 20, 23, 24, 27, 33 and 36 discloses a modular system for preparing aqueous coating materials comprising a module (I), a module (II), and a module (III), and optionally a module (IV) of a rheology control additive. Wherein a module (I) is equivalent to a base color (A1) specified in claim 1. A module (II) is equivalent to an aqueous color-imparting base color (A2) specified in claim 1. And a module (III) is equivalent to a pigment-free aqueous varnish specified in claim 1.

Independent claim 3 and dependent claims 18, 19, 21, 22, 25, 26 and 28 discloses a process for preparing an aqueous coating material with precisely defined shade and optical effect comprising mixing modules different in material composition and function and stored separately from one another, shortly before application of the

coating material such that the modules (I), (II), (III) and (IV) are the same as specified in claim 2 and correspondingly to (A1), (A2) and (B) and (C) in the present claim 1.

Therefore, claims 1,2 and 3 and their dependent claims are stand together.

Reusmann discloses a mixer system for preparing water-dilutable coating compositions comprising a plurality of base colors (A) and at least one pigment-free component (B), and at least one rheology-controlling additive. Each of a plurality of base color component (A) contains less than 5% by weight of water, at least one coloring and/or special-effect pigment, an organic solvent, and at least one water-thinnable or water-dispersible first binder and, if desired, auxiliaries and additives, column 2, lines 61-67 and claim 1 at columns 16 and 17. Component (B) comprises a pigment-free an aqueous dispersion of polyurethane resin=second binder, column 3, lines 1-3 and claim 1 at column 17, lines 5-17. The component (B) comprises at least one rheology-controlling additive, column 10, lines 63-64. A rheology additive is readable for being the same component (C) in the present claims. The first binder in the component (A) and the second binder in the component (B) (in the case of a binder mixture) can be the same binder, column 13, lines 25-26, column 4, lines 52-55 and column 9, lines 7-12. The polyurethane resins as binders are suitable binders for use in waterborne paints, column 3, lines 64-67. The components (A) and (B) and a rheology additive in Reusmann's invention are readable in the present claims as being (A1) and (B) and (C) in the independent claim1 and modules (I) and (III) and (IV) in the

independent claims 2 and 3. Reusmann discloses that to prepare the aqueous coating compositions the various base colors (A) are mixed in a proportion which results in the desired shade, column 13, lines 7-9. The mixing proportion of component (A) with the component (B) or the various components (B) can obtain the resulting coating composition having the desired viscosity, the desired solids content and the desired content of organic solvents that are depended on the intended use of the aqueous coating compositions, column 13, lines 9-17. The component (A) can comprise any customary paint pigment, provided that it does not react with water within a short time and that it does not dissolve in water. Reference discloses that particularly preferred base colors component (A) based on special-effect pigments comprising from 0.5 to 50% by weight of at least one special-effect pigment. Particularly preferred base colors (component (A)) are based on organic coloring pigments, column 12, lines 26-48. However, it is possible to employ as component A base colors which comprise a combination of at least one organic coloring pigment and at least one inorganic coloring pigment, column 12, lines 56-59 and column 3, lines 7-35. Suitable coloring pigments based on inorganic compounds include titanium dioxide, iron oxide, carbon block and the like, column 3, lines 30-31. Suitable coloring pigments based on organic compound are Indanthrene blue and the like, column 3, lines 32-34. Suitable special-effect pigments which are commonly employed in the formulation of aqueous coating composition include aluminum bronzes, the aluminum bronzes chromated and other metal flake pigment, column 3, lines 18-28. The special-effect pigment is readable in (A1) in the present claim 1 and module (I) in the present claims 2-3. The coloring

pigment such as titanium dioxide, iron oxides and carbon black are readable as being a color-imparting pigment in the present claims. Reference is teaching that the combination of coloring pigments is acceptable for making an aqueous coating composition. The incorporation of titanium dioxide is known for being a white color-imparting pigment, or a carbon black for a black color-imparting pigment. Reusmann does disclose a mixture of a component (A) having a special-effect pigment with a component (A) having a coloring-impart pigment. There is no reaction between the special-effect pigments and coloring pigments. Both, special-effect pigment and coloring pigment in the dispersed form are present in the formulation of (A) compositions components. The solvents are water-soluble or water-thinnable solvents, such as alcohols, column 4, lines 61-62. The amount of the ingredients for a formulation of an aqueous coating composition is not critical because it is depending on the intended use of the aqueous coating compositions, column 13, lines 9-17. The coating compositions can be applied by spraying on various substrates in multicoats, wherein the substrates include metal, wood, plastic or paper, column 13, line 43 through column 14, line 17. The base colors compositions (A) can be mixed with a suitable amount of the aqueous component (B). Reusmann discloses all ingredients for a formulation of an aqueous coating composition that are readable in the present claims.

The difference between the present claims and Reusmann invention is that Reusmann does not disclose an (A2) of an aqueous coating composition comprising a

color-imparting pigment, binder and water. However, this coloring pigment is present in the formulation of (A) compositions component together with a special effect pigment.

Kawakami discloses compositions for an aqueous coating a paper. A composition includes a convention pigment, binder and water, abstract and page 1, line 4, page 2, lines 30-32, page 3, lines 11-8, page 8, lines 13, and 23-24 and 29-32.

Both references disclose an aqueous coating composition comprising a colorant such as for example, titanium dioxide, binder and water. Both references disclose the same utility of using an aqueous coating composition for coating a paper substrate.

It would have been obvious to one of ordinary skill in the art to modify the aqueous coating composition in Reusmann by incorporating the composition of Kawakami in order to impart enhanced water resistance and desired solids content and physical properties of coating composition, because the addition composition based on binder, conventional pigment and water could be expected in Reusmann for obtaining the desired coating color and the desired solid content with the intended use of the aqueous coating composition in Reusmann at column 13, lines 11-17, and because a color-imparting pigment is present in the resulting aqueous coating composition in Reusmann invention.

(11) Response to Argument

The examiner would like to note that appellants do not traverse the Examiner's position that the aqueous coating composition in Reusmann comprises a plurality of base colors (A) comprising color-effect pigment and coloring pigment, organic solvent and binder; and a pigment-free component (B) comprising a binder and water wherein a binder can be the same binder. Also, appellants do not argue that the amount of binder, water, solvent and solid content of pigments can be varied depending on the intended use of the aqueous coating composition.

Appellants' argument is that Claims 1, 2 and 3 are nonobvious over Reusmann et al., U.S. 6,403, 701 in view of Kawakami et al EP 0081994 because the cited combination fails to (i) disclose all of the requirement elements of claims 1, 2, or 3; and (ii) the cited combination fails to provide any motivation to do that Applicant has done.

(i) The appellants' argument is Patent 6,403,701 does not disclose or suggest a composition comprising the combination of Applicant's components (A1) and (B) with a component (A2) that requires binder, pigment and water, such that the component (A2) is the aqueous base color having color-imparting pigment.

The primary reference to Reusmann can be considered as individual reference.

Reusmann discloses all ingredients for a formulation of an aqueous coating composition that are readable in the present claims. The presence of a special-effect

pigment with a color-imparting pigment in the base colors (A) components with a mixture of (B) component(s) will affect to color-imparting pigment in the resulting-final obtained coating composition. It does not matter where said color-imparting pigment could be present in a solvent medium composition (A1) or in an aqueous medium composition (A2). The coloring pigments based on inorganic compounds, column 3, lines 30-32 in Reusmann, are not organic solvents soluble wherein organic solvents are recited in Patent 6,403,701 at column 4, lines 60-65. The incorporation of coloring pigments usually takes place by dispersing the respective pigments with the binders, which are preferably employed in the form of solutions in organic solvents, column 5, lines 30-34. The coloring pigments are not reactive material. Thus, the coloring pigments are dispersed in the base colors (A) components, and subsequently said coloring pigments are dispersed in the resulting aqueous coating composition. The amount of the ingredients for a formulation of an aqueous coating composition is not critical because it is depending on the intended use of the aqueous coating compositions, column 13, lines 9-17. For these reasons the coating composition in Reusmann'701 will have the same resulting expectation as the aqueous coating composition in the present claims.

(ii) The appellants' argument is that the secondary reference to Kawakami et al EP 081994 describes a paper coating composition that require a particular thermosetting resin, conventional pigment, binder and water. Coatings in EP'994 disclose a pigment-filler and that titanium dioxide is not suggestive of being a color

pigment, page 8, lines 23-25 in EP'994. However, the term "pigment" is colored substance/ material used suspended in a vehicle as a paint or ink (from the dictionary). Titanium dioxide is white color pigment. Pigment is present in a dispersed form in water, page 22, line 14. Thermosetting resin and binder are readable in the formulation of an aqueous coating composition in the present claims and in Reusmann invention. An aqueous coating composition is used for coating a paper substrate.

Reusmann discloses that "the aqueous coating compositions can be applied to a very wide variety of substrates, such as, for example, metal, wood, plastic or paper," column 13, lines 44-46. Reusmann discloses the various base colors (A) components are mixed with aqueous at least one pigment-free component (B) or the various components (B), column 13, lines 7-10 and claim 1 at column 17. Any additional aqueous base having color pigment dispersion would be expected in the aqueous coating composition in Reusmann for color-imparting property for obtaining the desired shade of the aqueous coating composition, column 11, lines 64-67.

Both reference disclose aqueous coating compositions comprising a colorant=pigment, binder and water. Both references disclose the same utility of using an aqueous coating composition for coating a paper substrate. For these reasons it would be obvious to combine the teachings of these two references for modifying an aqueous coating composition in Reusmann by employing a composition of Kawakami as addition composition based on binder, conventional pigment and water for obtaining the desired coating color and the desired solid content for a coating composition. Thus,

with regards to appellants' position that the cited references fails to provide any motivation to combine the teachings of these references is not persuasive.

Appellants are further reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

For the above reasons, it is believed that the rejections should be sustained.

The present application 10/018,336 has been transferred to other examiner Olga Asinovsky within the same Art Unit 1711.

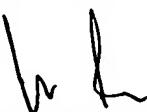
Respectfully submitted,

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August 12, 2005


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